

### **Remarks**

Reconsideration is requested in view of the above amendments and the following remarks. Claims 1-5, 7, 10-17, and 24-37 are pending.

#### **I. Prior art cited by Examiner**

On page 5 of the office action, US Patent 6,585,163 is used in rejecting claims 24-30. However, this reference is not listed on the Examiner's Form-892 or on any previous listing of references that have been made of record. Applicant requests that the Examiner list this reference on a Form-892 and return the form to the Applicant with the next communication.

#### **II. Amendments**

The specification has been amended to correct a typographical error.

Claim 1 has been amended to recite an identity card, at least one of the major surfaces including card holder information, the communication marking enables the card to be tracked within card processing equipment, and the communication marking is formed from non-visible ink. The amendments are supported by the original disclosure, for example, page 5, lines 24-27; page 6, lines 20-21; page 7, lines 7-11 and 20-23.

Claims 6 and 8-9 have been canceled, without prejudice or disclaimer, as a result of the amendment to claim 1.

Claim 7 has been amended to depend from claim 1.

Claim 10 has been amended to recite at least one of the major surfaces including information relating to the intended holder of the identity document, and the communication marking enabling the identity document to be tracked within identity document processing equipment, and the communication marking is formed from non-visible ink. The amendments are supported by the original disclosure, for example, page 5, lines 24-28; page 6, lines 20-21; page 7, lines 20-23.

Claim 12 has been amended to place it into better form.

Claim 17 has been amended as a result of the amendment to claim 10.

Claim 18-23 have been canceled at this time without prejudice or disclaimer in order to expedite prosecution.

Claim 24 has been amended to recite a method of verifying and tracking an identity card in equipment that is used to process identity cards. The amendments to claim 24 are supported by the original disclosure, for example, page 12, line 4 to page 13, line 14.

Claims 25-27 have been amended as a result of the amendments to claim 24.

Claim 28 has been amended to recite the reader as having a first channel intersecting the slot at the reading area at an acute angle relative to a longitudinal axis of the slot. The amendments to claim 28 are supported by the original disclosure, for example, page 10, lines 7-9 and page 11, lines 11-12 and Figure 7.

New claim 31 is supported by the original disclosure, for example, page 10, lines 10-13 and Figure 7.

New claims 32-37 are directed toward a card processing system, and are supported by the original disclosure, for example, page 12, line 4 to page 13, line 18 and Figure 8.

No new matter has been added by these amendments.

### **III. Prior Art Rejections**

Claims 1-5, 8-9, 18-21 and 23 are rejected under 35 U.S.C. § 102(b) as anticipated by CA 2,260,551 to DeBois.

Claims 6-7, 10-17 and 22 are rejected under 35 U.S.C. § 103(a) as unpatentable over DeBois in view of US Patent 6,632,042 to Leiner Chin et al. (Leiner Chin).

Claims 24-30 are rejected under 35 U.S.C. § 103(a) as unpatentable over DeBois in view of US Patent 6,585,163 to Meunier et al. (Meunier)

Applicant respectfully traverses these rejections and reconsideration is requested in view of the following.

DeBois does not teach an identity card that has at least one communication marking on at least a portion of the perimeter edge surface where the marking is formed from non-visible ink. Therefore, DeBois does not anticipate claim 1.

The Examiner, in rejecting claim 10, has relied upon Leiner Chin to teach the use of non-visible ink, and concludes that the use of non-visible ink in DeBois would have been obvious to a person having ordinary skill in the art. Applicant respectfully traverses.

DeBois teaches providing edge markings to enable a user to visually identify a card when in a wallet or contained within a stack of cards (see page 5, lines 1-6). In order to achieve such visual identification in DeBois, the edge markings must be visible to the user.

Leiner Chin mentions printing using UV ink. However, there is no teaching in DeBois to use UV ink or any form of non-visible ink to form the edge markings, as DeBois specifically teaches away from using non-visible markings. The use of non-visible markings on DeBois would destroy the result that DeBois seeks to achieve, namely visual identification of a card based on a visual reading of the edge markings. Since the proposed modification would destroy the result that DeBois seeks to achieve, there is no suggestion or motivation to make the proposed modification and the claims are not rendered obvious. See MPEP 2143.01, pages 2100-131 and 2100-132, Original Eighth Edition, August 2001, Rev. 2, May 2004.

Furthermore, even though Leiner Chin mentions UV ink, Leiner Chin does not disclose using such ink on the perimeter edge of a card to enable a card to be tracked within card processing equipment (as recited in claim 1) or within identity document processing equipment (as recited in claim 10).

Therefore, claims 1 and 10 are patentable over DeBois, and DeBois in combination with Leiner Chin.

With respect to claim 24, DeBois does not disclose a method of verifying and tracking an identity card in equipment that is used to process identity cards. The edge marking in DeBois are used for visual identification by a user, and not for verifying and tracking purposes within processing equipment.

Meunier discloses an encoded sheet material that is used in, for example, a photocopier or a printer. Meunier does not disclose a method of verifying and tracking an identity card in equipment that is used to process identity cards. The sheets in Meunier are not equivalent to identity cards, and the code is used for an entirely different purpose than the claimed communication marking, namely to optimize printing that later occurs on the sheet.

Claim 24 is directed toward a method of tracking and verifying an identity card in equipment used to process identity cards. As disclosed, it is important to prevent card holder information from being added to the wrong card, and to ensure that the correct card has been, or will be attached, to the correct mailer form. Neither DeBois or Meunier are faced with such concerns. As a result, claim 24 is not obvious in view of DeBois and Meunier.

With respect to claim 28, Meunier is relied upon to teach an edge reader 30. However, very little detail of the edge reader 30 in Meunier are disclosed. In particular, Meunier does not disclose a first channel, in which the light source is positioned, that intersects the slot at the reading area at an acute angle relative to a longitudinal axis of the slot. Meunier discloses an edge reader 30 but does not indicate how the light source is positioned, or whether the edge reader includes a channel as claimed.

As a result, claim 28 is patentable over DeBois and Meunier

The dependent claims have not been addressed, as they depend from allowable independent claims. Applicant does not concede the propriety of the rejections to the dependent claims and reserves the right to file arguments at a later date specifically addressing the dependent claims.

#### **IV. New Claims**

New claim 31 depends from claim 28 and is allowable along with claim 28. New claims 32-37 are allowable over DeBois, Leiner Chin, and Meunier, as the references do not teach card processing systems.

#### **V. Conclusion**


In view of the above amendments and remarks, all claims should be in condition for allowance. Favorable reconsideration is respectfully requested. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.



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Respectfully submitted,

MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, Minnesota 55402-0903  
(612) 332-5300

  
James A. Larson  
Reg. No. 40,443